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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,339	07/10/2000	Nobuyoshi Morimoto	5596-00300	9759

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EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/613,339

Applicant(s)

MORIMOTO, NOBUYOSHI

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This Office action is in response to Applicant's Response, filed on 4/28/2004.
2. Claims 1-44 are presented for examination.
3. The rejection to claims 1-44 under 35 U.S.C. 103 (a) as being unpatentable over Andrews in view of Treyz as set forth in the Office action mailed on 1/13/2004 is maintained.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-44 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Andrews (U.S. Pat. No. 6,285,986) in view of Treyz et al. (U.S. Pat. No. 6,587,835).

**As per claims 1, 9-13, 29, 30, 35 and 37-44 Andrews** substantially discloses a method of interactive, automated registration, negotiation and marketing for combining products and services from one or more vendors together to be sold as a unit allows vendors of products and services to post information about their (which is readable as

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Applicant's claimed invention wherein it is stated that a method for negotiating improved terms for a product or service), comprising:

in response to said detecting, making an offer to said purchaser to accept or reject a contract for negotiating said improved terms within a specified time (see., abstract, col 8, lines 45-67, col 2, lines 37-48);

if said purchaser accepts said offer:

conducting a search for said improved terms within said specified time; receiving said improved terms within said specified time; and executing said contract (see., abstract, col 8, lines 45-67, col 2, lines 37-48). It is to be noted that Andrews fails to explicitly disclose a commitment to purchase with associated terms for said product. However, Treyz discloses a system in which users make financial commitment toward purchases (see., abstract, col 1, lines 49-52, col 11, lines 63-67, col 12, lines 1-10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Andrews by including the limitation detailed above as taught by Treyz because this would provide commitment toward purchases prior to completing purchase transactions.

**As per claims 2, 8, 31 and 36 Andrews** discloses the claimed method wherein said detecting comprises detecting said purchaser entering a credit card number or a pre-paid account number or a gift certificate number (see., col 2, lines 37-48, please note that Andrews discloses a method of payment and shipping information, it is

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obvious to realize that the form of payment information can also include payment by credit card or gift certificate or account number).

**As per claims 3-7, 32, 33 and 34, Andrews** discloses the claimed method wherein said detecting said purchaser viewing a particular web page (see., col 1, lines 65-67, col 2, lines 1-14).

**As per claims 14, 20 and 22-28 Andrews** discloses a system of interactive, automated registration, negotiation and marketing for combining products and services from one or more vendors together to be sold as a unit allows vendors of products and services to post information about their (which is seen to read as Applicant's claimed invention wherein it is stated that a method for negotiating improved terms for a product or service), comprising:

detecting an issuance of a commitment to purchase with associated terms for said product or service being purchased by a purchaser using an Internet web site (see., abstract, col 1, lines 65-67, col 2, lines 1-14);

in response to receiving said notification, making an offer to said purchaser to accept or reject a contract for negotiating said improved terms within a specified time (see., abstract, col 8, lines 45-67, col 2, lines 37-48);

if said purchaser accepts said offer:

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conduct a search for said improved terms within said specified time; receive said improved terms within said specified time; and execute said contract (see., abstract, col 8, lines 45-67, col 2, lines 37-48).

**As per claims 15 and 21 Andrews** discloses the claimed limitations wherein said detecting comprises detecting said purchaser entering a credit card number or a pre-paid account number or a gift certificate number (see., col 2, lines 37-48, please note that Andrews discloses a method of payment and shipping information, it is inherent to realize that the form of payment information can also include payment by credit card or gift certificate or account number).

**As per claims 16-19 Andrews** discloses the claimed limitations wherein said detecting said purchaser viewing a particular web page (see., col 1, lines 65-67, col 2, lines 1-14).

#### RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 4/28/2004 have been fully considered but they are not persuasive.

#### REMARKS

7. In response to Applicant's arguments, Applicant argues that the cited art (Andrews) fails to anticipate, teach, or suggest:

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a. "Making an offer to said purchaser to accept or reject a contract for negotiating said improved terms within a specified time". Based upon foregoing rejection indicated above, it is believed that Andrews discloses this limitation in the abstract, col 8, lines 45-67, col 2, lines 37-48, specifically wherein said the vendor is prompted to determine whether or not the vendor is willing to negotiate on quantity of the product/service available for a bundle, and the vendor is not willing to negotiate terms when this product is included within a bundle... and the process wherein said within a specified time see., col 2, lines 37-48, specifically wherein said if the user has the highest bid at the end of the specified time period, then the user enters the payment and shipping information. Please note that in col 8, lines 14, at the step 123, if the vendor of the product/ service is willing to have the product/service included in a bundle which will be auctioned.

### ***Conclusion***

**8. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Pierre Eddy Elisca

Primary Patent Examiner

July 26, 2004